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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/664,195	09/17/2003	Todd M. Bjork	M81.12-0068	3894

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MINNEAPOLIS, MN 55402-3319

EXAMINER

RAMANA, ANURADHA

ART UNIT	PAPER NUMBER
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3733

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/26/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/664,195

Applicant(s)

BJORK ET AL.

Examiner

Anu Ramana

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 November 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 and 27-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,8,9,15,16,19,21,22 and 27-30 is/are rejected.
- 7) ☒ Claim(s) 3-7,10-14,17,18,20,23-25 and 31 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 9/17/03 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a). Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1 and 9 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 and 9 of copending Application No. 10/732,491. Although the conflicting claims are not identical, they are not patentably distinct from each other because the only difference between the claims of the present application and the claims of the copending application is that the claims of the copending application include many more elements and are thus more specific. Thus the invention of the claims of the copending application is in effect a "species" of the "generic" invention of the claims of the present application. It has been held that the generic invention is "anticipated" by the "species." See *In re Goodman*, 29 USPQ2d 2010 (Fed. Cir. 1993). Since the claims of the present application are anticipated by the claims of the copending application, they are not patentably distinct from the claims of the copending application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

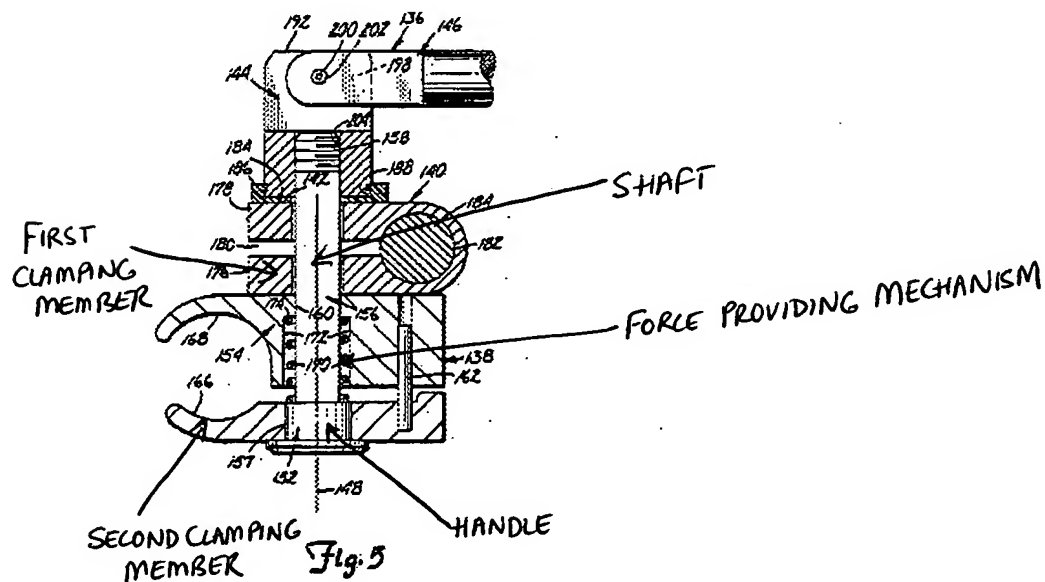
The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

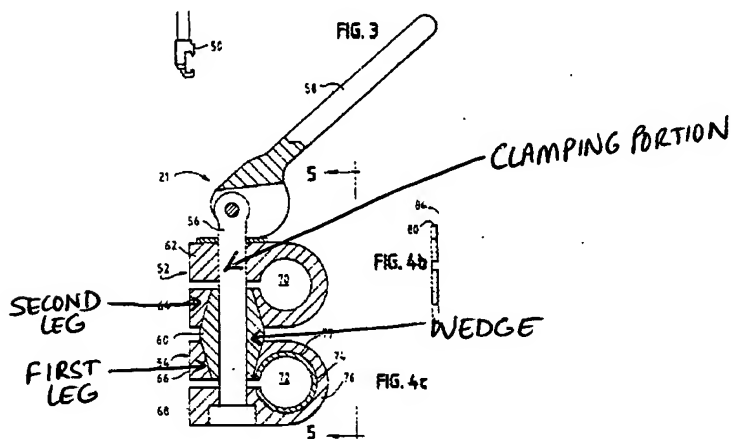
(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2 and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by LeVahn et al. (US 4,949,707).

LeVahn et al. disclose a surgical joint including a first clamping member, a second clamping member a shaft 156 positioned within the attachment end of the first clamping member and in communication with the second clamping member and a spring or "force providing mechanism" 170 disposed about the shaft wherein a handle is attached to the force providing mechanism (Fig. 5, col. 6, lines 48-68 and col. 7, lines 1-19). See marked up Fig. 5 below.



Farley et al. disclose a surgical clamp including a clamping portion 56, a first leg 54 and a second leg 64 and a wedge 60 disposed between the first and second legs wherein the wedge is movable to force the legs in opposite directions (Fig. 3 and col. 3, lines 29-40). See marked up Fig. 3 below.



Mata et al. disclose a surgical clamp for clamping two elongated members (80, 90), a mechanism 53 that constricts the opening of the clamping cavity of both members generally simultaneously and a handle 60 fixedly attached to the mechanism (Fig. 1, col. 2, lines 57-67, col. 3 and col. 4, lines 1-37).

Phillips discloses a clamp having a pin 20 extending through a clamping member into a clamping cavity, a pin activating mechanism or wedge 44 that moves pin 20 into the clamping cavity placing the clamping member in a clamping position; and a spring 28 that biases pin 20 into the clamping cavity (Fig. 2, paras [0017] - [0020]).

Response to Arguments

Applicant's arguments submitted under "REMARKS" in the response filed on November 20, 2006 have been considered.

It is noted that the Examiner cannot send out a Notice of Allowance unless a Terminal Disclaimer is filed in the instant application and the copending application 10/732,491.

Applicants' arguments with respect to the rejections of claim 1, 2 and 8 as being anticipated by LeVahn et al. are not persuasive. It is noted that a handle is, "any part designed to be held with a hand (Source: The American Heritage® Dictionary of the English Language: Fourth Edition. 2000)." Clearly, 152 is capable of being held by a hand, at least during assembly of the LeVahn et al. device. It is noted that Applicants are not claiming the function of their handle in claim 1 in order to patentably distinguish over LeVahn et al.

Further, the law of anticipation does not require that the reference "teach" what the subject patent teaches, but rather it is only necessary that the claims under attack "read on" something in the reference. *Kalman v. Kimberly Clark Corp.*, 218 USPQ 781 (CCPA 1983). Furthermore, the manner in which a device is intended to be employed does not differentiate the claimed apparatus from the prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

Applicants' arguments with respect to the rejections of claims 15-16 and 19 as being anticipated by Farley et al. (US 6,033,363) are not persuasive for the following reason.

"Unitary construction" only implies that the first leg and the second leg are units or "mechanical parts." It is suggested that Applicants recite that the clamping portion includes or comprises a first leg and a second leg to tie the first leg and the second leg to the same clamping portion.

Applicants' arguments with respect to Mata et al. are not persuasive because Applicants are not claiming the function of their handle in claim 21 to patentably distinguish over Mata et al. As stated earlier, a handle is, "any part designed to be held

with a hand (Source: The American Heritage® Dictionary of the English Language: Fourth Edition. 2000).” Clearly, 60 is capable of being held by a hand, at least during assembly of the Mata et al. device.

Applicants’ arguments with respect to the rejection of claim 28 over Greenstein et al. are persuasive. Therefore, the Examiner is withdrawing this rejection.

Allowable Subject Matter

Claims 3-7, 10-14, 17-18, 20, 23-25 and 31 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The indicated allowability of claims 28-30 is being withdrawn due to the rejections made in this office action. The Examiner sincerely apologizes for any inconvenience caused to the Applicants by this action.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anu Ramana whose telephone number is (571) 272-4718. The examiner can normally be reached Monday through Friday between 8:00 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner’s supervisor, Eduardo Robert can be reached at (571) 272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

AR
February 20, 2007

A handwritten signature in black ink, appearing to read "Anuradha Ramana". The signature is written in a cursive, flowing style.